



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/771,467	12/20/96	VAN VORIS	P B-1075-F2C2

EXAMINER

15M1/0513

PAUL W ZIMMERMAN K1 53
INTELLECTUAL PROPERTY SERVICES
BATTELLE MEMORIAL INSTITUTE
PACIFIC NORTHWEST DIVISION P O BOX 999
RICHLAND WA 99352

LEVY, N
ART UNIT PAPER NUMBER

1502

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DATE MAILED: 05/13/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-29 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-29 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received In Application No. (Series Code/Serial Number) _____
- ☐ received In this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Applicant is requested to submit relevant prior art, if aware if any.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §130 as follows:

The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).

Applicant is requested to correct status language. The 08/484,967 application does not refer to application 08/350,432, as a parent. It is unclear to which application this one is a continuation of, and which a C.I.P.. Applicant is requested to clarify, and identify C.I.P. material.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. In *re* Thorington, 418 F. 2d 528, 163 USPQ 644 (CCPA 1969); In *re* Vogel, 422 F. 2d 438, 164 USPQ 619 (CCPA 1970); In *re* Van Ornam, 686 F. 2d 937, 214 USPQ 761 (CCPA 1982); In *re* Longi, 759 F. 2d 887, 225 USPQ 645 (Fed. Cir. 1986); and In *re* Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.132 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly own with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are rejected under the judicially created doctrine of double patenting over claims 1-36 and disclosure of copending Application No. 08/484,967.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The '484 claims and disclosure provides the same polymers pesticides and methods of the instant invention.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. In re Schneller, 3297 F, 2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP §804.

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Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no proper antecedent for claim 34 hydrophobic.

In claims 1, 24, it is unclear as to the meaning of "bound"-simple mixing results in binding. The carrier should be identified, as should the polymer and pre polymers. It is unclear as to (claim 4) what is intended to be the inner and what is intended to be the outer, parts of a polymer. Low and high density require specific explanation in the specification; at present they are indefinite; as is low vapor pressure. High density pre polymer, or (claim 7) high density polyethylene vinyl acetate, or low, requires identification.

Claim 10 is incongruous-polyethylene is a polymer not prepolymer. Trademarks need proper identification to be identified as such, and should be presented as the generic components in the claims. In claim 16, "proximate" is ambiguous- it is taken to mean near.

Claims 18, 19 thus are indefinite at best, as it is unclear how untouched wood is fully impregnated.

Claim 25 is unclear; as are there 2 polymer envelopes- the outer hydrophobic?

Claim 26 is just not understandable to this examiner in that

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common terms seem to now being given uncommon meanings.

Mylar, saran are tradenames and should be generically identified in the claims. It is unclear how predetermined release rates are identified.

Claims 4, 6, 9, 10, 12, 13, 18-20, 24-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not seen where the polymer has inner part as carrier, outer as casing for same polymer. Copolymer of thermoplastic polymers and thermoset polymer is not disclosed- combinations are. High density or low density prepolymers are not disclosed as being polymerized with other pre polymers. It is not shown how to attain efficacy at a distance, within a wooden structure. The enveloping of carriers, pesticides, polymers and parts of polymers is not supported as claims are written.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled

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the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-13, 16, 18-26 are rejected under 35 U.S.C. § 102(e) as being anticipated by Price et al 5,492,696.

Microcapsule carriers are combined with actives including fungicides (antimicrobial/algacidal) slow release wood treatment compositions (col. 4, lines 60-64, col. 11, lines 30-35, col. 5, lines 18-24). Carriers are polymers, monomers or polymerizable materials (col. 6, lines 9-34) in liquid form of carrier/pesticide complex, within a surrounding matrix. Fungicides are utilized of the instant invention (col. 7, 8). Release rates are controllable by artisan, Polymers are of the instant invention (col. 9), combined with acrylic vinyl and polyurethane polymers and prepolymers (col. 12, line 50- line 10, col. 13) to treat wood. The pesticides are in liquid form, as microcapsule are filled by capillary action. Example 10 shows polymerization (curing) of pre polymer after mixing of pesticide. Hardened coating of acrylic and vinyl would produce the instant claim 7 high density polyethylene vinyl acetate polymers (col. 12, lines 56-61). low vapor pressure pesticides are utilized- tetracycline (examples 6-10), as are water soluble pesticides (copper).

Claims 1, 2, 8, 9, 11-16, 20-23 are rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson 5,317,834.

The instant fungicides (tables III and VII) are mixed and

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bound to polymer (sawdust, wood pulp- col. 15, lines 19-21), and combined with a polymer urea formaldehyde- col. 10, lines 35-43) and encased in a polymeric receptacle/pillow/bag (col. 15) for treating of wood object (trees cols. 18, 19). Low density polyethylene prepolymers can be used (col. 16, lines 62-68) with water soluble copper sulfate, sodium borate fungicide/fertilizers, and specified fungicides of the instant invention.

Claims 1-9, 11-15, 24-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cohen.

Sustained release fungicides of the instant invention (cols. 3-6) are mixed with binding carriers (col. 1, summary col. 7, line 21+) which are then mixed with or coated with a polymer and finally forming hydrophobic polymers water insoluble, (col. 8) of polyesters and then coated with hydrophobic polymers (col. 11, lines 36-41), as application requires thus providing films and devices suitable for wooden object treatment.

Claims 1, 2, 4-16, 18-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fahlstrom 4,344,250.

Rods and films of hydrophobic rigid, high density polyethylene (col. 4, top) enclose liquid (chloropicrin) fungicides of the instant invention (col. 4, lines 41-58) bound to a carrier, as in Example III of PVA. Both low (chloropicrin) and high (VAPAM) vapor pressure fungicides are utilized.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office

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action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-29 are rejected under 35 U.S.C. § 103 as being unpatentable over Nitto J0039601 in view of Price, Cohen, Anderson, Fahlstrom and Itzel.

Nitto teaches application of a controlled fungicidal release device to a wooden object by insertion. The fungicides of the instant invention are bound to a polymer. As shown above, Cohen Anderson and Fahlstrom provide fungicide slow release device useful for treating wooden object.

Itzel also provides slow release device useful for application to wood to prevent decay or retard deterioration (col. 2). The device (figure) is made by mixing and binding actives in liquid solution with a polymer (col. 6, lines 17-20) then covered with a hydrophobic polymer and further covered with a sheet or film of mylar or saran form polymers (col. 3, lines 32-10). Polymers

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include wax, rubber, PVC, polyvinyl acetates, polyesters acrylates, and olefinic polymer (col. 3, lines 40-53).

Fungicides include the instant.

Thus one of ordinary skill in the fungicidal arts would find it obvious to prepare and apply fungicidal devices, as shown by Nitto, Cohen, Price, Anderson, Fahstrom and Itzel, with the particular polymer, fungicide and form of delivery a result effective parameter determinable by artisan as desired for purpose of optimization and adjustment of length of treatment, initial dose required, species of pest to be treated, for example. Further, no criticality or objective showing of nonobvious or unexpected results is seen by the applicant to distinguish over the prior art.

There is no unusual and/or unexpected results obtained since the prior art is well aware of the use of polymers as a means of encapsulating fungicides in order to provide controlled release treatment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Page can be reached on (703) 308-2927. The fax phone number for this Group is (703) 305-5408.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

NLevy:evh
May 10, 1997

Neil S. Levy
NEIL S. LEVY
PATENT EXAMINER
GROUP 1500